Remarks/Arguments:

Reconsideration of the application is requested.

Claims 24-30 and 32-48 are now in the application. Claim 24 has been amended. Claim 31 is being cancelled herewith. Claim 48 has been added. Support for claim 48 can be found on pages 9 and 10 of the specification. No new matter has been added.

In the second paragraph on page 2 of the above-identified Office action, claims 24-27, 29-34, 36-37, 40-42, 44, and 47 have been rejected as being fully anticipated by Flick (U.S. Patent No. 7,134,175) under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claim 31 and on pages 9-10 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 24 calls for, *inter alia*:

determining a traverse path for moving the tool based on the actual determined position, inserting the tool into the tool chuck with a tool gripper on the determined traverse path, and positioning the tool into the tool chuck.

The Flick reference discloses a method for fastening a tool (36) in a tool holder (34), wherein an actual position of a tool (36) is determined by measurement of the tool while **in the tool holder (34)**. The actual position is compared with a desired position and the tool and the tool (36) is **moved** in the tool holder (34) using a **push rod** (38) until the desired position is reached (column 3, lines 42-45 and Fig. 2).

Contrary thereto, the new claim 24 of the patent application discloses a method for fastening a tool 22 into a tool chuck 20, in which an actual position of a tool 22 is determined, a traverse path is determined on the basis of the determined actual position; and the tool 22 is **inserted** into the tool chuck 20 by means of a **tool gripper** 40 via the determined traverse path.

The Flick differs from claim 24 of the patent application in that Flick does not disclose a tool gripper, which inserts the tool into the tool chuck. In addition, Flick measures the position while the tool is already in the tool chuck and not, as claimed in claim 24, chronologically prior to inserting it into the tool chuck. Flick discloses monitoring the position of the tool (36) while the tool is moved. Flick does not disclose determining a traverse path.

As seen from the above-given remarks, the reference does not show determining a traverse path for moving the tool based on the actual determined position, inserting the tool into the tool chuck with a tool gripper on the determined traverse path, and positioning the tool into the tool chuck, as recited in claim 1 of the instant application.

Since claim 24 is allowable over Flick, dependent claims 25-27, 29-34, 36-37, 40-42, 44, and 47 are allowable over Flick as well.

Even though claim 24 is allowable over Flick, the following further remarks pertain to the non-obviousness of claim 24.

Flick discloses a device which, uses a push rod (38), to move a tool (36) in a direction within the tool holder (34) (column 3, lines 42-45).

Accordingly, in Flick it follows that the tool (36) must first be inserted into the tool holder (34) so that it can be subsequently positioned and measured. On account thereof, the tool holder (34) must be heated for a long period of time, which can cause the tool itself to heat up. This can lead to the fact that the tool can no longer be positioned in the tool chuck (34) due to the heat expansion of the tool itself.

The present invention as claimed provides the benefit that because of the provision of a tool gripper 40 for inserting the tool 20 into the tool chuck 20, the tool can be measured prior to being inserted into the tool chuck 20. In this case, the tool is inserted into the tool chuck 20 using the tool gripper 40 via the determined traverse path.

The present invention as claimed, permits the measurement of the tool 22 without being heated by the heat applied to the tool chuck 20. Moreover, when subsequently inserting the tool 22 into the tool chuck 20, the operator does not have to face the risk of burns connected with the heat of the tool chuck

20. Furthermore, it is possible to position the tool 22 reliably in two directions of the rotation axis, namely into and out of the tool chuck 20.

In the last paragraph on page 6 of the Office action, claim 39 has been rejected as being obvious over Flick (U.S. Patent No. 7,134,175) in view of Freyermuth et al. (U.S. Patent No. 6,629,480) (hereinafter "Freyermuth") under 35 U.S.C. § 103. Freyermuth does not make up for the deficiencies of Flick. Since claim 24 is allowable, dependent claim 39 is allowable as well.

In the third paragraph on page 7 of the Office action, claim 43 has been rejected as being obvious over Flick (U.S. Patent No. 7,134,175) in view of Haimer (U.S. Patent No. 7,062,847) under 35 U.S.C. § 103. Haimer does not make up for the deficiencies of Flick. Since claim 24 is allowable, dependent claim 43 is allowable as well.

In the first paragraph on page 8 of the Office action, claims 24-26, 28-36, 38, 40-42, and 45-47 have been rejected as being obvious over Haimer (U.S. Patent No. 6,861,625) in view of Flick (U.S. Patent No. 7,134,175) under 35 U.S.C. § 103.

The Haimer reference does not disclose a tool gripper. Accordingly, Haimer does not disclose that the tool inserted into the tool chuck using a tool gripper via on a traverse path determined based on the actual position.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest **all** the claim limitations.

The references do not show or suggest determining a traverse path for moving the tool based on the actual determined position, inserting the tool into the tool chuck with a tool gripper on the determined traverse path, and positioning the tool into the tool chuck, as recited in claim 24 of the instant application.

The Haimer reference does not disclose a tool gripper. Accordingly, Haimer does not disclose that the tool inserted into the tool chuck using a tool gripper via on a traverse path determined based on the actual position.

As seen from the above-given remarks, Flick does not disclose the above-noted feature. Therefore, Flick does not make up for the deficiencies of Haimer.

The references applied by the Examiner **do not** teach or suggest all the claim limitations. Therefore, there is no *prima facie* case of obviousness.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 24. Claim 24 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 24, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 24-30 and 32-48 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,

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